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10/594,268	09/26/2006	Jordi Tormo i Blasco	5000-0198PUS1	4662
2292 7590 12/12/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER MANOHEAR, MANU M				
ART UNIT		PAPER NUMBER		
1617				
NOTIFICATION DATE		DELIVERY MODE		
12/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

## Application No.

10/594,268

## Applicant(s)

TORMO I BLASCO ET AL.

## Examiner

MANU M. MANOHAR

## Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 09/26/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***The status of the Claims***

Claims 1- 11 are pending in the application.

### ***Priority***

This application has the filing date of September 26, 2006 and is a national stage application of PCT/EP05/03007, filed on March 22, 2005, and with foreign Germany Patent applications 102004015397, filed on March 26, 2004. **The examiner acknowledges the filing date of March 22, 2005.**

### ***Claim Rejections - 35 USC § 101 and 112***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.** See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 11 is drawn to the use of compounds I and II according to claim 1 for preparing composition suitable for controlling harmful fungi. Claim 1 is drawn to the fungicidal mixtures of controlling harmful fungi, which mixture comprises formula I and formula II in a synergistically effective amount, but, since the claim 11 do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

**Claims 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention**

In claim 10 the term 'an amount of from 1 to 1000g/100 kg' renders the claim indefinite. The term '1 to 1000g/100 Kg' is not defined by the claim and the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear what the term 1000g/100kg is being referred to.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Patent 2000053506 (listed in IDS, hereafter '506), in view of Pees et al (US Patent Application 5,593,996).** Claims 1-3 are drawn to a fungicidal mixture for controlling phytopathogenic harmful fungi, which mixture comprises 1) the triazolopyrimidine derivative of the formula I and 2) an anilide of the formula II with different substitution in a synergistically effective amount.

Reference '506 teaches the fungicidal compositions comprising at least two active ingredients having a synergistic effect against infection of plant diseases. One of the active ingredients comprises a substituted thiophene derivatives and (page 1 description of the invention, page 3 introduction) other one selected from a group of compounds. This reference do not specifically teach formula I as a triazolopyrimidine derivative in the composition. However Pees et al teaches the use of triazolopyrimidine (Abstract and column 41 claim 1) as a fungicidal in a composition.

It would have been prima facie obvious to one of the ordinary skill in the art at the time of invention to modify the composition of stated in '506, in view of Pees et al to

have effective composition for fungal treatment. Development of effective fungicidal composition for the crops like rice is very important in this art since effective compositions require a minimal application which in turn avoids the propagation of the microcidal resistant parasites. The composition with components like triazolopyrimidine and derivatives of anilide would serve this purpose. One of the ordinary skills in the art would have been motivated to develop an effective fungicidal mixture containing the well characterized triazolopyrimidine derivative and compounds like anilide derivatives in a composition. Since '506 teachings disclosed that composition with thiophene derivatives or anilide derivatives with additional ingredients containing derivatives of different compounds can be applied to several pathogenic fungi one of ordinary skill in the art would have a reasonable expectation that a modification of the composition with thiophene would be successful. The combined teachings of the reference '506, in view of Pees et al makes it prima facie obvious to one of ordinary skill in the art at the time of the invention to use thiophene derivatives and triazolopyrimidine in a mixture and develop an effective fungicidal composition.

**Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Patent '506, in view of Pees et al (US Patent Application 5,593,996) as applied to claims 1-3 above and further in view of Cotter et al (US Patent 6, 277,856).**

As stated above reference '506 teaches the fungicidal compositions comprising at least two active ingredients having a synergistic effect against infection of plant diseases. Pees et al teaches the use of triazolopyrimidine as a fungicidal in a

composition. These two references do not specifically teach the various obvious modifications in the application of the fungicide like ratio, quantity and the steps involved. Cotter et al teaches the various modifications in the application of the fungicidal mixture like ratio of the constituents and the quantities.

Claim 4 is drawn to the fungicidal mixture as claimed in claims 1 or 2 comprising the compound of the formula I and the compound of the formula II in a weight ratio of from 100:1 to 1:100. Cotter et al teaches the ratio of the compounds in the mixture can be from 1:100 to 100:1 (Column 5 line 13-15).

Claim 5 is drawn to a fungicidal composition comprising a liquid or solid carrier and a mixture according to claims 1 or 2. Cotter et al teaches the fungicidal mixture comprise a carrier that can be a liquid or solid form (Column 5 line 39-41).

Claim 6 is drawn to a method for controlling phytopathogenic harmful fungi, which comprises treating the fungi, their habitat or the seed, the soil or the plants to be protected against fungal attack with an effective amount of the fungicidal mixture as claimed in claim 1. Cotter et al teaches the method for controlling pathogenic fungi on plants such as rice (Column 8 line 52-56). Cotter et al also teaches the method of treating for plant, seed, foliage, or soil (Column 5 line 34-39) and it would be obvious to one of ordinary skill in the art to use the effective amount as a fungicide.

Claim 7 is drawn to a method according to claim 6, wherein the compounds I and II according to claim 1 are applied simultaneously, that is jointly or separately, or in succession. Cotter et al teaches the application of the component of the composition simultaneously or in succession (Column 8 line 18 -20).

Claim 8 is drawn to according to claim 6, wherein the compounds I and II or the mixtures are applied in an amount of from 5 g/ha to 1000 g/ha. Cotter et al teaches the composition can be applied 1 to 2000 g/ha [(grams per hectare) Column 4 line 66-68].

Claim 9 is drawn to the method according to claim 5, wherein the compounds I and II are applied in an amount of from 1 to 1000 g/100 kg of seed. Claim 10 is drawn to the seed comprising the mixture according to the claims 1 or 2 in an amount of from 1 to 1000g/100 kg. It is not clear from the claim the term 1000g/100g being refer to as stated above in 112 rejection. For the purposes of examination, the Examiner will interpret the recitation to mean 1 to 1000 g mixture per 100 kg seed. Cotter et al do not specifically teach the amount for 100g of seed however it teaches the range of active ingredients for 1000ml solvent (Column 7 Table line 15 -52) and also it teaches the composition contain active ingredients from 0.5% to 95% (column 8 line 13-15) hence the teaching would encompass the amount in the instant claims. In addition it would be obvious to one of ordinary skill in the art to modify the concentration of the composition according to the purposes unless the teachings are present to the contrary.

It would have been prima facie obvious to one of the ordinary skill in the art at the time of invention to modify the composition of stated in '506 in view of Pees et al to have effective composition for fungal treatment as stated above. These two references do not specifically teach the various obvious modifications in the application of the fungicide like ratio, quantity and the steps involved. Cotter et al teaches the various obvious modifications in the application of the fungicide like ratio of the constituents and quantity. There is a need in the art to effectively manage the fungi especially for crops



like rice with minimal application of the agents as well as to avoid the development of fungal resistance to the agents. One of the ordinary skills in the art would have been motivated to develop an effective fungicidal mixture containing the well characterized triazolopyrimidine derivatives and anilide in a composition. Since '506 teachings disclosed that composition with thiophene derivatives or anilide derivatives with additional ingredients containing derivatives of different compounds can be applied in certain ratios and quantities one of ordinary skill in the art would have a reasonable expectation that a modification of the steps with the composition would be successful. The combined teachings of the reference '506, in view of Pees et al, further in view of Cotter makes it prima facie obvious to one of ordinary skill in the art at the time of the invention to use thiophene derivatives and triazolopyrimidine in a mixture with certain ratios and quantity to develop an effective fungicidal mixture.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANU MANOHAR whose telephone number is (571)270-5752. The examiner can normally be reached on Mon - Thu 9.00AM to 4.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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